IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re application of

Thomas LEVY, et al.

Appln. No.: 10/541,694

Confirmation No.: 1929

Filed: August 5, 2005

For: SIGNALLING IN CONTROLLED ACTIVE NETWORKS

Docket No: Q88874

Group Art Unit: 2443

Examiner: George C NEURAUTER

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits

this Reply Brief in response to the Examiner's Answer dated August 3, 2009. Entry of this Reply

Brief is respectfully requested.

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STATUS OF CLAIMS

Claims 1-16 are pending in the present application. Claims 1-16 stand finally rejected.

The rejections of claims 1-16 are being appealed.

Claims 1-16 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Applicant's admitted prior art in view of DAN: Distributed Code Caching for Active Networks (Decasper, D. and Plattner, B., Proceedings of IEEE INFOCOM'98, April 1998, pp. 609-616).

REPLY BRIEF UNDER 37 C.F.R. § 41.41
U.S. Appln. No.: 10/541,694

Attorney Docket No.: Q88874

GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL

(A) Rejection of claims 1-16 under 35 U.S.C. § 103(a) as allegedly being unpatentable over Applicant's admitted prior art in view of DAN: Distributed Code Caching for Active Networks (Decasper, D. and Plattner, B., Proceedings of IEEE INFOCOM'98, April 1998, pp. 609-616).

ARGUMENT

At least for the reasons discussed below, Appellants submit that the rejections of the

claims on appeal are improper, and reversal of the grounds of rejection is requested.

First, Appellants submit that claims 1-16 are patentable for at least the reasons presented

in the Appeal Brief filed June 5, 2009.

Second, Appellants respond to certain arguments presented in the Examiner's Answer

dated August 3, 2009. In the Examiner's Answer, the Examiner provides several pages of

response to Appellants' arguments (beginning on page 10 of the Examiner's Answer).

In general, Appellants address some of the Examiner's response to Appellants' arguments

as follows:

A: The Examiner maintains that Appellants have presented arguments throughout the

Appeal Brief that "'AAPA' and 'DAN' do not teach sending active code to an active node upon

or in response to 'setting up a virtual circuit between a client terminal and a server terminal.'"

The Examiner then traverses this argument by contending that this limitation is not recited within

the claim (*see* page 10 of the Examiner's Answer).

However, Appellants respectfully submit that the Examiner first alleged on pages 5-6 of

the Office Action dated October 20, 2008, that "the Applicant did admit that the prior art disclose

wherein active nodes receive active code in response to setting up a virtual circuit between a

client and a server." Appellants rebutted this statement made by the Examiner, on pages 12-13

of the Appeal Brief, by pointing out that the Appellants had not made such an admission, and

that the Examiner's statement is incorrectly characterizing the AAPA and the Appellants'

arguments, because the AAPA is disclosing only that the active code to be deployed to an active

node is determined from the client or user terminal requesting the transfer of data. Nowhere in

the AAPA is there any teaching or suggestion that the active code is sent to the active node *in*

response to setting up a virtual circuit between a client and a server. Instead, the sending of the

active code to the active node in the AAPA occurs after the code to be deployed is determined

from the client or user terminal requesting the transfer of data, and is contained in the data stream

received by the active node. Specifically, the active code in the AAPA is associated with the

data stream by applications of a user and sent to the active node along with the data stream.

Therefore, the AAPA clearly does not teach or suggest that the active node receives the active

code *in response to setting up a virtual circuit between a client and a server*, **as the Examiner**

has alleged.

In view of at least the aforementioned reasons, Appellants emphasize that the AAPA fails

to teach or suggest "a signaling control unit comprising: means for receiving a request to set up a

virtual circuit between a client terminal and a server terminal; a virtual circuit set-up means; and

means controlled by the virtual circuit set-up means for sending active code to the active node,"

as recited in claim 1, and that DAN does not remedy these deficiencies of the AAPA.

B: Regarding claim 1, the Examiner refers to the arguments on pages 10-12 of the

Appeal Brief, as well as to pages 1 and 5 of the Appellants' specification, in reaching a

conclusion that it is allegedly clear by the Appellants' own admission that "the Session Initiation

Protocol is known in the art and that the Session Initiation Protocol is used by the means of the

claimed invention for the claimed features of receiving a virtual circuit request from a client

terminal and means for setting up a virtual circuit between the client terminal and a server

terminal" (*see* page 13 of the Examiner's Answer). The Examiner further submits on page 14 of

the Examiner's Answer that the Appellant allegedly has readily admitted that the Session

Initiation protocol is a known virtual circuit protocol and was known to be used by a signaling

control unit such as a SIP proxy to receive a virtual circuit from a client terminal and set up a

virtual circuit between the client terminal and a server terminal.

Appellants respectfully submit that the Examiner's statements categorizing the alleged

admissions by the Appellants *are incorrect and unsupported.*

To the contrary, the Appellants have only conceded, on page 1 of the Appellants'

specification, that "[v]arious prior art protocols, including the Session Initiation Protocol (SIP)

and the H323 protocol, enable the signaling control units to communicate with a network using

the Internet Protocol (IP), known as an IP network. The Session Initiation Protocol … regulates

exchanges between data transfer applications in real time over IP networks."

However, the Examiner appears to have relied heavily upon page 5 of the Appellants'

disclosure of the invention, in which it is disclosed that the setting up of the virtual circuit of the

present invention is managed by one or more signaling control units, the signaling control units

comprising means for receiving a virtual circuit request from a client terminal and means for

setting up a virtual circuit between the client terminal and a server terminal. Furthermore,

"[s]uch means may use the H323 protocol or the Session Initialization Protocol known in the art and all the means for communicating with an IP network with which signaling control units are conventionally provided" (*see* also pages 12-13 of the Examiner's Answer).

Accordingly, Appellants clearly do not concede the use in the prior art of the SIP by means of the claimed invention *for the claimed features of receiving a virtual circuit request from a client terminal and means for setting up a virtual circuit between the client terminal and a server terminal.* Instead, the Appellants' specification, in describing on page 5 an exemplary embodiment of the present invention, merely concedes *that the SIP protocol **has been used in the prior art**, but the prior art is silent regarding how the protocol may be used in the context of signaling control.*

As Appellants have disclosed on page 5 of Appellants' specification, **it is only in accordance with an exemplary embodiment <u>of the present invention</u>, that contemplates a use, by signaling control units, of the Session Initialization Protocol.** In other words, the SIP protocol only defines the protocol itself, but the prior art does not teach or suggest using such a defined protocol to do anything in particular, or to use the SIP protocol in the means as defined in the present invention. Thus, although the SIP protocol may be a known *type of protocol* in the prior art, *it is only with knowledge of the Appellants' invention* that would have led one of ordinary skill in the art to use the SIP protocol in a signaling control unit, the signaling control unit comprising means for receiving a request to set up a virtual circuit between a client terminal

and a server terminal, and virtual circuit set-up means, and means controlled by the virtual circuit set-up means for sending active code to the active.

C: Furthermore, the Examiner refers to RFC 2543 (*see* pages 14-16 of the Examiner's Answer), and RFC 2543 allegedly discusses the use of the SIP protocol as well as the servicing of *requests*. However, although general *requests* (such as invitations to join) are disclosed by RFC 2543, RFC 2543 makes no mention of the SIP proxy *setting up a virtual circuit* or even receiving a request to set up such a virtual circuit. Again, the Examiner has relied upon improper hindsight obtained from the Appellants' own disclosure of the present invention in concluding that the AAPA's mere inclusion of a SIP proxy within a signaling control unit suggests the setting up of a virtual circuit. None of the cited references, either alone or in combination, teaches of suggests the request to set up or the setting up of, *specifically*, a virtual circuit.

D: The Examiner reiterates, on pages 16-21 of the Examiner's Answer, the contention that the combined teachings of the AAPA and DAN would disclose every element as recited by claim 1. The Examiner has placed particular reliance on the AAPA, and states on page 16 of the Examiner's Answer that "[the] 'AAPA' disclosed means for receiving a request to set up a virtual circuit between a client terminal and a server terminal and a virtual circuit set-up means, ... and the combined teachings of 'AAPA' and 'DAN' teach means controlled by the virtual circuit set-up means for sending active code to the active node."

However, as discussed above, the AAPA does not at all teach or suggest, *inter alia*, means for receiving a request to set up *a virtual circuit* between a client terminal and a server terminal and *a virtual circuit set-up means*.

DAN fails to remedy the deficiencies of AAPA, at least because DAN also fails to teach or suggest, *inter alia*, "a signaling control unit comprising: means for receiving a request to set up a virtual circuit between a client terminal and a server terminal; a virtual circuit set-up means; and means controlled by the virtual circuit set-up means for sending active code to the active node," as recited in claim 1. DAN fails to teach or suggest any of a virtual circuit, a means for receiving a request to set up a virtual circuit, a virtual circuit set-up means, or means controlled by a virtual circuit set-up means for sending active code to the active node. In fact, DAN is completely silent on both *setting up a virtual circuit* as well and *a request to set up a virtual circuit*.

Therefore, due at least to the above-discussed deficiencies of the AAPA and DAN, neither the AAPA nor DAN, alone *or in combination*, teaches or suggests every element as recited by claim 1. Accordingly, Appellants submit that independent claim 1 is patentable over AAPA in view of DAN for at least these reasons. Claim 6 is a related independent method claim, and is also submitted to be patentable for similar reasons as discussed above. Claims 2-5 and 7-16 are dependent claims which are also patentable at least in view of their dependencies as well as for their additionally recited elements.

Appellants respectfully request the Board not to sustain the rejections of claims 1-16.

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CONCLUSION

For the above reasons as well as the reasons set forth in Appeal Brief, Appellant

respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal.

An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,

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